REMARKS/ARGUMENTS

The rejections presented in the Office Action dated October 20, 2009 (hereinafter Office Action), have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

With particular respect to claims 29 and 30, Applicant notes that the claims are not included in any statement of rejection. MPEP § 707.07(d) indicates that where a claim is refused the word "reject" must be used and the statutory basis for any ground of rejection should be designated by an express reference in the opening sentence of each ground of rejection. Since these claims are not rejected in the Office Action, Applicant is of the belief that these claims are allowable. If this was not the Examiner's intention, Applicant requests clarification, an opportunity to respond, and that any future rejections comply with MPEP § 707.07(d).

Applicant maintains that none of the asserted references have been shown to teach or suggest at least checking the state of a user interface component automatically in response to detecting a need to initiate a handover algorithm. The Office Action explicitly acknowledges that neither Koichi nor Kubosawa teaches such limitations at page seven and implicitly acknowledges that neither reference teaches such limitations at pages two and three. The further reliance on Motorola still fails to overcome these deficiencies in Koichi and Kubosawa. In addition, the combination of the asserted references would not suggest the claimed checking of a state of a user interface component automatically in response to detecting a need to initiate a handover algorithm as evidenced by the references.

Koichi

The Office Action asserts that Koichi teaches "checking a portable telephone to see if it is in a charging stand", and then if the telephone is in the charging stand, handoff processing is forbidden. This is in direct opposition to the claimed limitations where, first it is detected that there is a need to initiate a handover algorithm, and then in response, the state of a user interface component is checked. Since Koichi's telephone is immobile

(paragraphs [0048] and [0087]) when in the charging stand, the telephone cannot physically change between coverage areas of different base stations resulting in no need to perform a handoff. This is the stated purpose of Koichi – avoiding unnecessary handoff processing when the mobile telephone is in a fixed location. Thus, Koichi does not teach or suggest at least checking the state of a user interface component automatically in response to detecting a need to initiate a handover algorithm.

Kubosawa

The Office Action asserts that Kubosawa teaches automatically checking a user interface component in response to detecting a need for handover in steps S5 and S9 of Fig. 2. In contrast, Kubosawa teaches that handover is automatically performed in response to communication quality deterioration being detected in step S5 when handover is possible, *e.g.*, step S7. User input is only requested when handover is not possible (*e.g.*, step S7 and paragraphs [0032], [0054], and [0055]). Thus, in contrast to the Office Action's assertions, the asserted interface component of Kubosawa is not automatically checked in response to detecting a need to initiate a handover algorithm.

Motorola

The Office Action also asserts that Motorola teaches that the decision to handover is based on detecting a need for handover. This is acknowledged in at least paragraph [0003] of the instant application. The assertion, however, fails to provide any correspondence to the limitations directed to checking the state of a user interface component in response to a need to initiate a handover algorithm or that further prevention of the handover algorithm is arranged on the basis of such triggered checking. The reliance on Motorola fails to provide any additional correspondence to the claimed limitations and does not overcome the acknowledged deficiencies in Koichi and Kubosawa.

While each of the asserted references is directed to situations where handover may be performed, none of the references has been shown to teach or suggest checking the state

of a user interface component automatically in response to detecting a need to initiate a handover algorithm. For example, in Koichi there is no need to initiate a handover algorithm and in Kubosawa at least the asserted component is not automatically checked. Since none of the asserted references teaches or suggests at least the claimed checking of the state of a user interface component automatically in response to detecting a need to initiate the handover algorithm, any combination thereof would also fail to correspond. Without correspondence to each of the claimed limitations, the § 103(a) rejections are improper.

Moreover, Applicant maintains that the asserted alignments of Koichi and Kubosawa fail to provide correspondence to the claimed limitations. For example, the "fixed" state of Koichi does not correspond to the claimed inactive state. Paragraphs [0009], [0048], and [0087] of Koichi indicate that the fixed state refers to a state where the portable telephone remains immobile in a single location. However, Koichi's portable telephone may be actively used by a user while located in the fixed state. Thus, the fixed state of Koichi fails to correspond to the claimed inactive state, which requires that the user interface component is not being actively used. Also, as previously pointed out, step S9 of Kubosawa merely refers to waiting to determine whether a user enters an input via keypad to provide permission for handover. Kubosawa makes no mention of handover algorithm prevention or checking a user interface component to prevent application of a handover algorithm, particularly when the user interface component is in an inactive state. Without correspondence to each of the claimed limitations, the § 103(a) rejections are improper, and Applicant requests that each of the rejections be withdrawn.

Dependent claims 2, 3, 8, 10-13, 19, and 22-28 depend from independent claims 1, 9, and 21, respectively, and each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the above-discussed combination of Koichi, Kubosawa, and Motorola. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with the independent claims. These

dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 2, 3, 8, 10-13, 19, and 22-28 are also patentable over Koichi, Kubosawa, and Motorola.

In addition, Applicant further traverses each of the § 103(a) rejections because the asserted modification of Koichi would improperly change the principle of operation of the teachings of Koichi. If a proposed modification would change the principle operation of the prior art being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01(VI). Koichi teaches that handoff is prohibited, or such prohibition is released, based upon attachment or detachment of a portable telephone to a charging stand. Modifying Koichi to rely on user input to determine whether handover should be performed, instead of making an automatic determination based on objective criteria, as asserted, removes Koichi's automatic determination and would require a user to provide input every time handover is executed. This would be an increased burden on Koichi's user and would remove the safeguard of automatically avoiding unnecessary handover processing when the telephone is in a fixed location. The asserted modification of Koichi would change the principle operation of Koichi to require user input every time the mobile station executes handover. A skilled artisan would not make such a change, and the asserted modification fails to support the rejections. Applicant accordingly requests that the rejections based upon such a modification of Koichi be withdrawn.

With respect to the § 103(a) rejections of dependent claims 5-7, 15-18, and 20 based upon Koichi, Kubosawa, and Motorola as combined with Claxton, Cowsky, III *et al.*, Wren, III, and Harris *et al.*, respectively, Applicant respectfully traverses. As discussed above, the combination of Koichi, Kubosawa, and Motorola fails to correspond to the limitations of independent claims 1 and 9 (from which claims 5-7, 15-18, and 20 depend). The further reliance on these additional teachings does not overcome the above-discussed deficiencies

in Koichi, Kubosawa, and Motorola. Thus, the asserted combinations of these teachings with the teachings of Koichi, Kubosawa, and Motorola do not teach each of the claimed limitations of dependent claims 5-7, 15-18, and 20, and each of the § 103(a) rejections should be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.083PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8500 Normandale Lake Blvd., Suite 320
Minneapolis, MN 55437
952.854.2700

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By: /Erin M. Nichols/

Erin M. Nichols
Reg. No. 57,125